

U.S. Application No. 10/017,640 Examiner Ouellette Art Unit 3629  
Response to July 1, 2004 Office Action

### RESPONSE

In response to the Office Action dated July 1, 2004, Assignee respectfully requests reconsideration based on the following remarks. Assignee respectfully submits that all pending claims are in condition for allowance.

The United States Patent and Trademark Office (the "Office") rejected claims 1, 6, 10-13, 16-18, and 26-31 under 35 U.S.C. § 103(a) as being unpatentable by Eldering et al. (U.S. Patent Application No. 2002/0123928 A1) in view of Ludtke (U.S. Patent No. 6,202,210) and rejected claims 2, 3, 5, 7-9, 14, 15, and 19-24 under 35 U.S.C. § 103 as being unpatentable over Eldering et al. (U.S. Patent Application No. 2002/0123928 A1) in view of Ludtke (U.S. Patent No. 6,202,210). The Assignee shows, however, that the pending claims are not disclosed, anticipated, and/or obviated by the cited documents. Thus, the Assignee respectfully submits that the pending claims (claims 1-3, 5-24, and 32-41) are ready for allowance.

#### ***§103 Rejection – claims 1, 6, 10-13, 16-18, and 26-31:***

The Office rejected claims 1, 6, 10-13, 16-18, and 26-31 under 35 U.S.C. § 103(a) as being unpatentable by Eldering et al. (U.S. Patent Application No. 2002/0123928 A1) in view of Ludtke (U.S. Patent No. 6,202,210). If the Office wishes to establish a *prima facie* case of obviousness, three criteria must be met: 1) combining prior art requires "some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill"; 2) there must be a reasonable expectation of success; and 3) all the claimed limitations must be taught or suggested by the prior art. DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2143 (orig. 8<sup>th</sup> Edition) (hereinafter "M.P.E.P."). As the Assignee shows, however, the combination of *Eldering* and *Ludtke* fails to teach or suggest the claim limitations. The Assignee, then, respectfully requests Examiner Ouellette to remove the rejection and to allow claims 1, 6, 10-13, and 16-18. Please note that claims 26-31 are canceled, and, consequently, a response to the rejection of claims 26-31 is not presented.

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The combination of *Eldering* and *Ludtke* does not obviate the pending claims. Independent claim 1 recites utilizing information relating to *a subscriber to identify the subscriber* that includes analyzing information to determine *the subscriber's desirability in relation to a provider, wherein the subscriber's desirability is used to identify the subscriber to the provider*. Independent claims 16 and 17 similarly recite the feature of analyzing subscriber information to determine *the subscriber's desirability in relation to a provider, wherein the subscriber's desirability is used to identify the subscriber to the provider*.

1. (Currently Amended) A method for utilizing information relating to a subscriber to identify said subscriber comprising:

receiving data from a plurality of programming and advertising sources;

receiving viewing information associated with the subscriber, the viewing information indicating whether the subscriber viewed data from at least one of the programming and advertising sources and a source other than the plurality of programming and advertising sources;

receiving a subscriber attribute, the subscriber attribute comprising data about the subscriber;

merging said data from plurality of programming and advertising sources, said viewing information, and said subscriber attribute to create a subscriber information data store;

*analyzing said subscriber information data store to determine said subscriber's desirability in relation to a provider, wherein said subscriber's desirability is used to identify said subscriber to said provider.*

U.S. Patent Application No. 10/017,640, currently amended claim 1 (emphasis added by Assignee). *See also*, paragraphs 69-77 and FIGS. 6 and 7A-7C.

*Eldering*, however, describes systems and methods for matching advertisements to groupings of subscribers by correlating *advertisement profiles* with *subscriber profiles* to predict "traits about the *subscribers* without revealing any private data or raw transaction data associated with the subscribers." (U.S. Patent Application No. 2002/0123928 A1 to *Eldering*, claim 1; *see also* Abstract and col. 6, paragraphs 88 and 89). As further described in *Eldering*,

... No matter what the form of the subscriber profile, it is done in a way to protect the privacy of the subscriber. That is, the subscriber's identity is not known or given out, and raw transaction data is not available for distribution and is discarded after it is processed or at standard intervals, such as every night.

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U.S. Patent Application No. 2002/0123928 A1, col. 6, paragraph 87. *See also*, FIGS. 17A, 17B, and 17C (illustrating characterizations). *Eldering*, then, fails to teach a method or system as recited in claims 1, 16, and 17 that *identifies a subscriber* by analyzing information to determine the subscriber's desirability in relation to a provider. *Ludtke* fails to cure the deficiencies of *Eldering*. *Ludtke* describes a data collection and retrieval system within a home AV network that may be used to affect the "scheduling of television broadcasts, test marketing of products which are complimentary to the products which are already in the consumer's home AV network, or even monitoring the equipment and software for upgrade and service opportunities." (U.S. Patent 6,202,210 to *Ludtke*, column 7, lines 42-47). As further described in *Ludtke*:

By examining the hardware and software on home AV network 120, a utility program. . . could inform the user about associated products which might be of interest (marketing & promotion). The utility program could monitor a vendor's web site (or other remote location) and automatically notify the user if hardware upgrade or product recalls might be available, based on analysis of the product on the network. The product manufacturers which support data mining can generate revenue by charging the companies who use this data, as it is collected and sent to them.

U.S. Patent 6,202,210 to *Ludtke*, column 9, lines 26-36.

For these reasons and others, the combination of *Eldering* and *Ludtke* fails to disclose or suggest independent claims 1, 16, and/or 17. Because the combination of *Eldering* and *Ludtke* fails to teach or suggest the claimed invention, claims 1, 16, and 17 would not have been obvious to one of ordinary skill in the art. The Assignee, then, respectfully asks Examiner Ouellette to remove the §103 rejection of independent claims 1, 16, and 17. And because claims 6, 10-13, and 18 depend upon these independent claims, *Eldering* and *Ludtke* cannot teach or suggest these claims. Accordingly, Assignee respectfully requests Examiner Ouellette to remove the § 103 rejection and to allow the pending claims.

***§103 Rejection – claims 2, 3, 5, 7-9, 14, 15, and 19-24:***

The Office rejected claims 2, 3, 5, 7-9, 14, 15, and 19-24 under 35 U.S.C. § 103 as being unpatentable over *Eldering et al.* (U.S. Patent Application No. 2002/0123928 A1) in view of *Ludtke* (U.S. Patent No. 6,202,210). As the Assignee shows, however, the combination of *Eldering* and *Ludtke* fails to teach or suggest the claimed subject matter. The Assignee, then,

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respectfully requests Examiner Ouellette to remove the rejection and to allow claims 2, 3, 5, 7-9, 14, 15, and 19-24.

The combination of *Eldering* and *Ludtke* does not obviate the pending claims. As discussed in the sections above, independent claim 1 recites utilizing information relating to a subscriber to identify the subscriber that includes analyzing information to determine the subscriber's desirability in relation to a provider, wherein the subscriber's desirability is used to identify the subscriber to the provider. Independent claims 16 and 17 similarly recite the feature of analyzing subscriber information to determine the subscriber's desirability in relation to a provider, wherein the subscriber's desirability is used to identify the subscriber to the provider. *Eldering*, however, describes systems and methods for matching advertisements to groupings of subscribers by correlating advertisement profiles with subscriber profiles to predict "traits about the subscribers without revealing any private data or raw transaction data associated with the subscribers." (U.S. Patent Application No. 2002/0123928 A1 to *Eldering*, claim 1). *Eldering*, then, fails to teach a method or system that identifies a subscriber to a provider by analyzing information to determine the subscriber's desirability in relation to a provider. And, as further discussed above, *Ludtke* fails to cure the deficiencies of *Eldering*.

For these reasons and others, the combination of *Eldering* and *Ludtke* fails to disclose or suggest independent claims 1, 16, and/or 17. And because claims 2, 3, 5, 7-9, 14, 15, and 19-24 depend upon these independent claims, *Eldering* and *Ludtke* cannot teach or suggest these claims, and consequently, claims 2, 3, 5, 7-9, 14, 15, and 19-24 would not have been obvious to one of ordinary skill in the art. The Assignee, then, respectfully asks Examiner Ouellette to remove the §103 rejection and to allow the pending claims.

***New claims 32-41:***

This amendment adds claims 32-41. Support for new claims 32-34 is found in paragraphs 42 (disclosing "... other video source. . .") and 51 (disclosing "... the program inserts data describing the other video source 404 into the subscriber content-choice database (128) . . .") and FIG. 4. Support for new claims 35-41 is found throughout the specification and

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figures including paragraphs 35-37, 68, and 69-77. The number of independent claims is now seven (7), and the total claims are now thirty-three (33). The Assignee includes \$88 each for the three (3) extra independent claims (\$264) and \$18 each for the four (4) excess claims (\$72). The Assignee, therefore, includes a Credit Card Payment Form PTO-2038 for \$336.

### **CONCLUSION**

All of the rejections have been overcome. Further, none of the references cited by Examiner Ouellette, alone or in combination, disclose or suggest the claimed invention. Therefore, Assignee respectfully solicits a Notice of Allowance for all pending claims (claims 1-3, 5-24, and 32-41).

### **AUTHORIZATION FOR PAYMENT OF FEES**

If there are any other fees due in connection with the filing of this response, please charge the fees to the credit card on file. If a fee is required for an extension of time under 37 C.F.R. 1.136 not accounted for above, such an extension is requested and the fee should also be charged to the credit card on file.

If the Office has any questions, the Office is invited to contact the undersigned at (757) 253-5729 or [bambiwalters@cox.net](mailto:bambiwalters@cox.net).

Respectfully submitted,



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